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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,566	12/20/2004	Dae Whang Kim	930086-2006	6782

7590 03/27/2007
Ronald R Santucci
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745 Fifth Avenue
New York, NY 10151

EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/518,566	KIM ET AL.	
	Examiner	Art Unit	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Status of Claims:

Claims 1-5 are pending.

Claims 1-5 are rejected.

DETAILED ACTION

Priority

1. It is noted that the examiner has been acknowledged that the application is a 371 of PCT/KR03/01244 (06/25/03); its foreign priority document, Republic of Korea 10-2002-0036051 (06/26/2002) is in the file.

Drawings

2. None.

Claim Objections

Claim 1 is are objected to because of the following informalities:

In claim 1 , the term “ comprising ”or “comprises” is absent in the claim. This particular term is necessary in the processing claim due to its dependent limitations.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Ritter et al Scott et al (GB 2,038,810) .

Scott et al discloses the process for the production of isobutyl[2-[4-chlorophenoxy]phenoxy]prionate in the following example 2 (see page 4, lines 25-35):

Preparation of R-isobutyl(2-[4-chlorophenoxy]phenoxy)propionate

4-(4-chlorophenoxy)phenol (6.61 g, 0.03 mole), potassium hydroxide (1.68 g, 0.03 mole) and ethanol were refluxed for 1 hour. The solution was evaporated to about 50 ml bulk and toluene (500 ml) was added and the mixture distilled until the temperature was 110°C. At this time a fine solid suspension had separated from the stirred refluxing solution. S-isobutyl lactate mesylate (6.72 g, 0.03 mole) was added dropwise over 1 hour and the mixture stirred and refluxed for 18 hours. The mixture was washed with water and the toluene layer evaporated to give a brown oil which was distilled under reduced pressure to produce the desired compound.

This is identical with the claims.

Claim Rejections - 35 USC § 103

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Ritter et al Scott et al (GB 2,038,810) .

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Scott et al discloses the process for the production of isobutyl[2-[4-chlorophenoxy]phenoxy]prionate in the following example 2 (see page 4, lines 25-35):

Preparation of R-isobutyl(2-[4-chlorophenoxy]phenoxy)propionate

4-(4-chlorophenoxy)phenol (6.61 g, 0.03 mole), potassium hydroxide (1.68 g, 0.03 mole) and ethanol were refluxed for 1 hour. The solution was evaporated to about 50 ml bulk and toluene (500 ml) was added and the mixture distilled until the temperature was 110°C. At this time a fine solid suspension had separated from the stirred refluxing solution. S-isobutyl lactate mesylate (6.72 g, 0.03 mole) was added dropwise over 1 hour and the mixture stirred and refluxed for 18 hours. The mixture was washed with water and the toluene layer evaporated to give a brown oil which was distilled under reduced pressure to produce the desired compound.

The coupling reaction between the compounds of the formulae II and III is suitably carried out at elevated temperature, preferably at a temperature in the range 50 to 200°C. Generally, reactions in which A represents a hydrogen atom require a somewhat higher temperature than reactions in which the starting material is a pre-formed alkali metal phenolic salt. If A represents an alkali metal ion, the reaction temperature is preferably in the range 70 to 100°C; if A represents a hydrogen atom, the reaction temperature is preferably in the range 110 to 170°C.

If one of the reactants is a liquid at the reaction temperature, the reaction may be performed without an added solvent. However, a suitable solvent, for example an optionally-substituted aromatic compound, preferably a hydrocarbon, such as toluene or xylene, may be used.

(see page 2, lines 30-38).

However, the instant invention differs from the prior art in that the water is removed by using a cooling condenser is unspecified.


Even so, such a equipment is well-known in the art; furthermore, the prior art process has used the distillation process, which is commonly involved in using that type of equipment; therefore, it would be obvious to be motivated to use removed by using a cooling condenser in the prior art process in order to obtain the desired product to its completion. This is because such a manipulation to be expected in the purview of the skilled artisan in the art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor Victor Oh, MSD, LAC
Primary Examiner
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